

REMARKS

Applicants respectfully request reconsideration of the prior art rejections of Claims 1-48 set forth by the Examiner under 35 U.S.C. §§ 102 and 103. Applicants have amended the claims herein to more clearly define the invention. Applicants respectfully submit that the prior art references of record whether considered alone, or in combination, fail to either teach or suggest Applicants' presently claimed invention.

Applicants respectfully reconsideration of the rejections under § 102. Applicants note that Broadwin, U.S. Patent No. 5,929,850, is directed to an system and method in which static images are broadcast to a user's TV, substantially in place of the main program through the use of a proprietary still image broadcast channel. The system allows a viewer to select an option to view a linked still image broadcast on the still image channel. See Col. 2, lines 53-66. In one embodiment, when a user navigates through the still images on a main screen, the original TV program is displayed in a small window overlaid on the still image. See Col. 3, lines 6-9. By utilizing such a system, Broadwin attempts to simulate an internet-like interactive feature. On the other hand, Applicants' invention is directed to a system and method for displaying a small window comprising banner advertisements or the status of the first program overlaid on top of a normal video channel when the subject matter on the video screen is changed during a segment of a first program.

More specifically, Applicants invention allows a broadcaster or a user to overlay promotional banners over a main program, which advantageously can remain onscreen when the user changes channels or web surfs during a segment of the original program such as, for example, during an advertisement period, and which can be clicked to bring up new images, video or other information. Alternatively, a banner can be used during a commercial break to

countdown the time until the main program begins again, or to display other relevant information such as sports scores. Moreover, the banner advertisement or status window can be linked to other information retrieved through the broadcast or internet connections and stored on the device, or linked back to the same or different broadcast video channel. The Broadwin reference simply provides no teaching or suggestion regarding these advances and only discloses an invention whereby still images related to a TV program are displayed over the entire screen based upon the information sent over a separate, proprietary "still image broadcast channel."

With respect to claims 1, 11, and 17, Broadwin merely discloses a window region which continues to display the original TV program while viewing thumbnail still images. See Col. 3, lines 6-9. The Examiner asserts that Broadwin discloses a window which sets forth a banner advertisement met by the commercial segment in Col. 9, lines 35-57 or Col. 6, lines 50-60. On close inspection, the cited portions state that the TV broadcast signal may comprise a commercial such as, for example, a commercial for a Sun SparcStation computer. See Col. 6, lines 53-56 & Col. 9, lines 52-55. Nonetheless, it is the broadcast signal of this original programming which is displayed in the Broadwin window while the viewer looks at still images about the broadcast programming on the video screen. In sharp contrast, however, Applicants' invention recites displaying banner advertisements or a status window while simultaneously displaying information other than the original programming on the video screen when the subject matter is changed during a segment of the original program. For example, this implicates those situation in which a user may channel surf or invoke another function on the TV during an advertisement period. Even though a banner advertisement may in some circumstances correspond to a commercial being run on the

original channel, this does not equate to merely displaying the same original programming in a reduced size window. Significantly, Broadwin simply does not teach that the window is displayed when the subject matter of the video screen is changed during a segment of the original programming. Broadwin simply provides that still images related to a program may be accessed by a user by choosing from available options. Additionally, in the Applicants' invention, the information other than the original programming comprises, for example, a live broadcast received via a regular broadcast.

More specifically, in one embodiment, the Applicants' window contains a counter that indicates to the user when the commercial break will be over. (See Applicants Specification, p. 7, lns 19-22) This counter remains while the user continues to surf or view other channels, or surf the web. In another embodiment, this window contains sports scores relevant to the main program, that remain on the screen while the user changes channels or surfs the web during a segment of the original program. (See Applicants Specification, p. 8, lns 5-8) Broadwin simply does not teach or suggest Applicants' claimed features. Consequently, these claims now stand in condition for allowance.

In addition, the Examiner argues that Broadwin further discloses circuitry for receiving an AV broadcast signal from a first source, i.e., a broadcast center and circuitry for receiving still images from a second source, i.e., media server. With respect to Claim 25, Applicants claim the means to provide information to be displayed in a banner window when the user elects not to view the main program. For example, if a viewer decides to channel surf or surf the web during a commercial, the means provides information to be displayed in a banner window somewhere on the screen. Conversely, Broadwin only allows additional information to be viewed based on the current channel being watched, and significantly does

Application No. 09/449,016
Admt. Dated September 20, 2004
Reply to Office Action of April 21, 2004

not allow the user to change channels or web browse and still maintain the original programming on the screen. Consequently, Braodwin neither teaches nor suggests the advances in the art.

In reference to claim 36, 38, 39, and 42, Broadwin simply does not teach about or suggest mechanisms by which either the user or the system may selectively turn on or turn off the small status window or banner advertisements without disturbing the main program on the TV screen. In fact, Broadwin does not even disclose that a regularly received broadcast signal may be displayed on the Tv screen but rather discloses that only still images trnasmitted via a special still image channel may be displayed. Therefore, these claims not stand in condition for allowance.

Applicants respectfully request reconsideration of rejection of dependent claims 3, 4, 5, 6, 9, 14, 15, 18, 22, 24, 26, 27, 29, 31, 37,40, 41, 43, and 44 as they each are dependent on base claims which now stand in condition for allowance as set forth in the above section. In light of the foregoing remarks and amendments, Applicants respectfully submit that claims 1, 3-6, 9, 11, 14, 15, 17, 18, 22, 24-27, 29, 31, and 36-44 all now stand in condition for allowance.

Applicants respectfully request reconsideration of the obviousness rejections set forth by the Examiner under 35 U.S.C. § 103. None of the references either alone or in combination teach or suggest the Applicants' presently claimed invention.

In regard to Examiner's rejection of claims 2 and 8 in light of Broadwin in view of Sibecas, U.S. Patent No. 6,167,235, Applicants respectfully submit that their new invention is patentably distinct. As stated above, the Broadwin patent does not provide any teaching or suggestion to support the rejection to the base claims of Applicant's invention contained in

claims 2 and 8. Moreover, Sibecas does not add any support to the teaching of Broadwin.

Sibecas is directed to a method of delivering additional advertising information to a client's mobile device such as, for example, a pager or a cell phone, based upon an advertisement broadcast on a TV. In Sibecas, a prompt is shown in the corner of a TV commercial, indicating that additional information is available over the mobile network. This prompt does not change from commercial to commercial. See Col. 3, lines 36-39. Therefore, when the commercial is over, the icon will disappear if the next commercial does not support additional information over a mobile device, or it will stay up, unchanged, to indicate that additional information is also available via mobile device in the next commercial. Sibecas simply does not teach or suggest changing the subject matter of the video screen window to another regularly received TV channel (as set forth in claim 8) or modifying what is changed in the window region (as set forth in claim 2) when the user changes channels on the TV. Although the system in Sibecas presumably supplies different signals to the mobile device based on user selections, it simply does not teach or suggest changing the subject matter of the small status screen window or changing the subject matter to another regularly received TV channel. Finally, claims 2 and 8 depend from base claims which now stand in condition for allowance. In light of the foregoing remarks, Applicants respectfully submit that claims 2 and 8 now stand in condition for allowance.

Similarly, Applicants request reconsideration of the rejection of claims 7, 10, 16, 21, 23, 28, 45 and 46 based on Broadwin in view of Kikinis, U.S. Patent No. 5,929,849. As stated above, Broadwin does not provide any teaching to support rejection of the base claims, 1, 11, 17, and 25, of Applicants' invention contained in Claims 7, 10, 16, 21, 23, and 28. The Examiner correctly provides that Broadwin fails to set forth that changing of the subject

matter comprises using video screen to access the internet. However, Kikinis also fails to teach or suggest this advance in the art. Kikinis is merely directed to a method of providing video in which certain regions of the video are tagged with a uniform resource locator, URL. A user can click on part of an image, which will cause the device to connect to the internet and access the Web Page of the URL associated with the part of the image. As such, it is more appropriately describes inventions related to active regions which may be invoked by a user to perform an interactive function. Consequently, it simply does not teach or suggest that the subject matter may be changed to access the internet. Additionally, dependent claims 7, 10, 16, 21, 23, and 28 are in condition for allowance because they are based on independent claims which are allowable for the reasons set forth in the previous discussion.

With respect to claims 45 and 46, the cited references neither teach nor suggest modifying the position of the small window. The Examiner correctly states that this feature is not disclosed by Broadwin. Moreover, this feature is also not taught or suggested by Kikinis. Kikinis is directed to systems and methods for surfing the web using a television. In contrast, Applicant's invention allows for banners or images to be placed on a screen while the user is doing other tasks e.g. web surfing or channel surfing. The ability of the user to move these banners around, a key element of the claims, is neither taught nor suggested by Kikinis. This is important in circumstances where the user is not given an option to turn off the small window or where it is convenient to move the window to a substantially unused portion of the TV screen. Hence, Applicants respectfully submit that claims 45 and 46 stand in condition for allowance.

Applicants need not address the patentability of claims 12 and 13, as they are based on independent claim 11 that is now clearly allowable based on the above-noted distinctions.

In regard to Examiner's rejection of claim 19 based on Broadwin in view of Hymel, U.S. Patent No. 6,157,814, Applicants respectfully submit that their new invention is patentably distinct and contains sufficient novelty to overcome Examiner's rejection. As stated above, the Broadwin patent does not provide any teaching or suggestion which supports the rejection of Applicant's invention contained specified claim 19. In addition, Hymel is directed to an advertising technique in which advertisements are sent to a user's cell phone along with a time duration that dictates how long the advertisement is to be displayed for on the phone. See Col. 4, lines 1-3. In contrast, the time duration sent in Applicant's invention is used to inform the user of the remaining time until the main program begins again. This is evident in the language of the claim which recites "said video signal comprises a time marker for indicating the time duration of said commercial in said additional window." Moreover, claim 19 depends from independent claim 17 which now stands in condition for allowance. In light of the foregoing remarks, Applicants respectfully submit that claim 19 now stands in condition for allowance.

In regard to Examiner's rejection of claim 20 based on Broadwin in light of Hymel, U.S. Patent No. 6,157,814, in view of Sibecas, U.S. Patent No. 6,167,235, Applicants respectfully submit that the claimed invention is patentably distinct and contains sufficient novelty to overcome Examiner's rejection. As the Examiner notes, the Broadwin and Hymel fail to provide any teaching or suggestion to support the rejection of Applicant's invention contained in claim 20. In addition, Sibecas add any support to the other cited references in relation to the §103 rejection. Applicants reemphasize that combining references of seemingly unrelated prior art in order to defeat patentability has not been allowed by the Federal Courts. The U.S. Court of Appeals for the Federal Circuit held in *Dembiczak* that

"Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." *In re Dembiczak*, 50 USPQ2d, 1614, 1617. (1999) Both Sibecas and Hymel are related to advertising in a wireless device network such as cell phones, and neither of these two references relate to Applicants' invention of an interactive TV system which presents banners and status windows when a user attempts to channel surf or perform other function to avoid advertisements on a TV program. Neither Sibecas nor Hymel suggest combining technologies in order to anticipate Applicant's invention by applying their own technologies to the field of Applicant's invention. Nonetheless, even if these references are combined, claim 20 depends from base claim 17 which now stands in condition for allowance. In light of the foregoing remarks, Applicants respectfully submit that claim 20 now stands in condition for allowance.

In regard to Examiner's rejection of claims 30, 34, and 37 based on Broadwin in light of Davis, U.S. Patent No. 6,138,155, Applicants respectfully submit that the claimed invention is patentably distinct and contains sufficient novelty to overcome Examiner's rejection. Applicants have amended the claims to further recite that a second signal for the small windows and banners is provided when a first signal is changed during a segment of the first signal. As set forth previously, Broadwin does not provide any teaching nor suggestion to support the rejection of Applicant's invention contained in claims 30, 34, and 37. In addition, Davis does not add any support to support §103 rejections of Applicants' claims. Davis involves downloading a software application that executes on the client computer, and thereafter communicating with pre-existing servers over the internet to send user tracking information back to the application provider. It simply does not teach or suggest that signals

Application No. 09/449,016
Admt. Dated September 20, 2004
Reply to Office Action of April 21, 2004

for the windows and banners are provided when a first signal is changed during a segment and that these signals are tracked. Consequently, Applicants respectfully submit that claims 30, 34, and 37 now stand in condition for allowance.

Applicants need not address the patentability of claims 32 or 33, as they are based on rejected base claim 30 that is now allowable based on the arguments above.

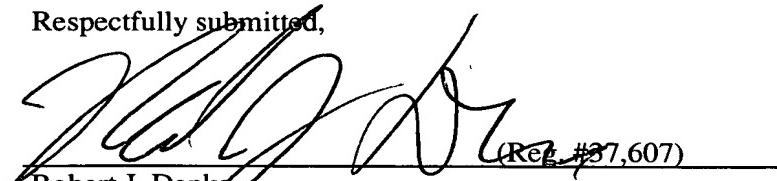
Applicants need not address the patentability of claim 35, as it is based on rejected base claim 34 that is clearly now allowable based on the arguments above.

Additionally, Applicants need not address the patentability of claim 48, as it is based on rejected base claim 34 that is now clearly allowable based on the arguments above

Applicants respectfully submit that the prior art references of record whether considered alone, or in combination, fail to either teach or suggest Applicants' presently claimed invention. In light of the foregoing, Applicants respectfully submit that all claims now stand in condition for allowance.

Date: 9/21/04

Respectfully submitted,



(Ref. #37,607)

Robert J. Depke
HOLLAND & KNIGHT LLC
131 S. Dearborn, 30th Floor
Chicago, Illinois 60603
Tel: (312) 263-3600
Attorney for Applicant

Application No. 09/449,016
Admt. Dated September 20, 2004
Reply to Office Action of April 21, 2004

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail on 9/21/04 in an envelope addressed to:

**Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**



Attorney for Applicant